

REMARKS

This amendment is in response to the Office Action of May 5, 2005 in which claims 1-10 were finally rejected.

It is noted that on May 16, 2005, applicant filed a Request for Withdrawal of the Finality of the above-mentioned Office Action for the reasons given in MPEP Section 706.07(a). That request is hereby renewed and it is believed that upon reconsideration the Examiner will agree to withdraw the finality of the last action and will further agree that the accompanying amendment introducing new claims is proper at this stage and should be examined. In particular, a new independent claim 11 is added covering the subject matter shown in Figure 2 along with a new dependent claim for each independent claim.

In the Office Action of May 5, 2005, the novelty rejection was withdrawn and therefore it is concluded that the Examiner acknowledges that the subject-matter according to present claims 1, 7 and 10, respectively, is new over the prior art according to Alperovich.

However, a new prior art document of Shaheen et al. is introduced with the present Office Action, and a rejection for obviousness of the claimed subject-matter with respect to a combined consideration of Alperovich and Shaheen is raised.

In particular, the Examiner asserts that Alperovich specifically teaches the whole subject-matter of e.g. claim 1 except "*switching center*".

Applicants believe this to be an undue generalization of the teaching conveyed by Alperovich, since the assertion stated in the half-sentence bridging pages 2 and 3 of the Office Action sets forth that, according to Alperovich, a decision step and a preventing step is done in a communication network. However, this does not seem to be a proper statement in connection with the present application, because surely any method step somehow related to the background of the present application would have to be effected in a communication network.

It appears therefore to applicants that a correct statement rather would have to acknowledge that a decision step and a preventing step according to the present invention is done in a switching center of a communication network, and that a record is kept in said switching center which are the features distinguishing the claimed subject-matter from the teaching conveyed by Alperovich and as admitted by the Examiner.

As already discussed in the reply filed February 2, 2005, the Alperovich teaching suffers from the drawback that a decision is effected in the HLR, this specific drawback being described in detail in the International Preliminary Examination Report which pointed out that keeping the record in the HLR, according to the prior art, only allows message restriction at the receiving end. See also page 2 of the present specification at lines 8-33 (corresponding to published paragraphs [0008]-[0010] of US 2002/0168978 A1 at page 1 thereof).

It would seem to Applicants that, in order to cure this deficiency, a skilled person would have had to recognize this drawback and then seek for related solutions to overcome the problem.

In Applicants' view, it is very questionable whether a person of ordinary skill in the art would have referred to Shaheen et al. The reason is that Shaheen is not concerned with a decision to allow a possible message delivery or not, but rather with the question whether a message delivery (or another feature utilization) is technically possible at all (see e.g. paragraph [0010]: "...*the system is required to know ... whether the mobile supports that vertical feature and the mechanisms by which the mobile accepts delivery of that feature*"). This means that the Shaheen reference does not correspond to the same background.

Anyway, even if the person of ordinary skill would consider the Shaheen reference, he could not arrive at the claimed subject-matter for the following reason.

Alperovich teaches to keep a record in the HLR, but Shaheen does not teach to keep a record in the MSC, but rather teaches that each mobile station (so-called "*subscribing units*") keep their own capability record (IU) which is provided to a protocol capability indication unit (PCIU) within the MSC according to needs. This is explained in the paragraph cited by the Examiner (0039) where it is said that "*the*

PCIUs... coordinate cooperation with respect to extended services and the delivery of extended services. Each of the subscribing units... includes an indication unit (IU)..., respectively, which indicates to one or more of the PCIUs...respective capabilities of the subscribing units”. Hence, Shaheen fails to teach that a “record containing information about certain addresses with which a message communication is not allowed... is kept in said switching center”.

Accordingly, even a combined consideration of Alperovich and Shaheen cannot render obvious the claimed subject-matter.

Thus, the Examiner’s stated motivation to combine, in order to enhance the MSC efficiency by including the HLR, fails to arrive at the claimed subject matter.

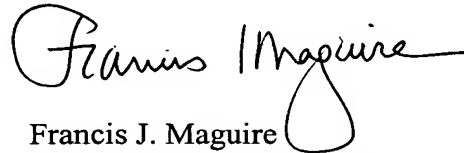
Furthermore, even if that were not the case, the Office Action has not identified where the applied references provide the motivating suggestion to make the modifications necessary to arrive at the claimed subject matter as required, *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). The mere fact that the prior art may be modified as suggested by the Examiner does not make the modification obvious unless the references themselves suggest the desirability of the modification, *In re Fritch*, 922 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

The present specification at page 1, line 21 through page 2, line 6, has already pointed out some of the shortcomings of the prior art solved by the present invention and clearly, in view thereof, the presently claimed invention is not only different from the prior art but better than, and not suggested thereby.

The dependent claims 2-6 and 8-10 rejected on the same ground are patentable at least for the reasons stated above in connection with the independent claims from which they depend.

Withdrawal of the obviousness rejection of claims 1-10 is respectfully requested along with entry of new claims 11-14 and allowance of all the pending claims 1-13 is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink that reads "Francis J. Maguire". The signature is written in a cursive style with a large, looped initial "F" and a trailing flourish.

Francis J. Maguire
Attorney for the Applicant
Registration No. 31,391

FJM/djc
WARE, FRESSOLA, VAN DER SLUYS
& ADOLPHSON LLP
755 Main Street, P.O. Box 224
Monroe, Connecticut 06468
(203) 261-1234